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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,409	07/15/2003	Robert A. Matousek	17237	9613

26637 7590 04/29/2005

CNH AMERICA LLC
INTELLECTUAL PROPERTY LAW DEPARTMENT
700 STATE STREET
RACINE, WI 53404

EXAMINER

MAMMEN, NATHAN SCOTT

ART UNIT PAPER NUMBER

3671

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,409

Applicant(s)

MATOUSEK ET AL.

Examiner

Nathan S Mammen

Art Unit

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/21/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,976,084 to Weber.

The Weber '084 patent discloses a rotary impeller for a tailings conveyor of an agricultural combine. The impeller comprises a mounting portion (98) mountable to a rotatable member (84) and a plurality of blades (100). The blades extend generally radially outwardly from the mounting portion. Each of the blades includes a surface facing in the rotational direction. The surface comprises a radially outmost threshing portion (106) and a tailings deflecting portion (generally, the center of blades 100) located between the mounting and threshing portions and having a convex shape. The Weber '084 patent does not disclose that the radially outermost threshing portion and the tailings deflecting portion are of indivisible unitary construction. Instead, the radially outermost threshing portion is bolted to the tailings deflecting portion. It would be obvious, however, to construct the impeller of the Weber '084 patent such that the radially outermost threshing portion and the tailings deflecting portion are of indivisible construction, since, as the Supreme Court has stated, "it involves no invention to cast in one piece an article which has formerly been cast in two pieces, and put together." Howard v. Detroit Stove Works, 150 U.S. 164, 170 (1893).

Regarding claims 2-8, 11-12, 14-15: The threshing portion is swept back at about a 30 degree angle relative to the radial innermost portion of the surface disposed between the deflection portion and the mounting element. The radially outermost portions of the blades (i.e., the threshing portion 106) have a predetermined extent in the direction of rotation greater than the extent of the deflection portion of the blades (100). The deflection portion leads the threshing portion (106) as the impeller is rotated. The impeller includes more than four blades (100) located at equally angularly spaced locations around the mounting portion. The impeller includes webs (102) connecting adjacent blades. The threshing portion (106) is swept back relative to the deflecting portion.

Regarding claim 9: The Weber '084 patent discloses the claimed invention, as stated in paragraph 2 above, except for the outermost threshing portion being substantially flat. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a flat outer threshing portion, since the Weber '084 patent teaches that the outermost threshing portion is a detachable rasp bar (col. 3, lines 35-36) and flat rasp bars are known.

Response to Arguments

3. Applicant's arguments filed 2/21/05 have been fully considered but they are not persuasive.

While the disclosure of the instant application supports the limitation that the threshing portion and the tailings deflecting portion are of indivisible construction (see Figs. 7-8), there is no discussion of the criticality or the benefits (beyond the inherent advantage of greater simplicity) of such a construction. As described above, the Supreme Court has held that it is

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obvious to form as one piece an article previously made of two pieces joined together. As the Federal Circuit's predecessor, the Court of Customs and Patent Appeals, has stated, "there is no invention in making parts integral instead of riveting or otherwise fastening them together." In re Prinzler, 97 F.2d 102, 104 (CCPA 1938). In this case, the two parts of the Weber '084 patent being joined together are a rasp bar (106 – the outermost threshing portion) and the web (100 – tailings deflecting portion). As one of ordinary skill in the art would understand, both parts are inherently constructed of metal. Thus, there is no impediment to their unitary construction. In addition, Applicant has provided no evidence that an integral construction is non-obvious. In re Wickersham, 75 F.2d 214, 215 (CCPA 1935). Finally, the holding of Detroit Stove Works is not a relic of IP law. See, e.g., Ex Parte Hiroshi Mukawa, 2001 WL 863752 (BPAI 2001) (unpublished) (affirming an examiner's obviousness rejection based on the separate-to-integral principle of Detroit Stove Works).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

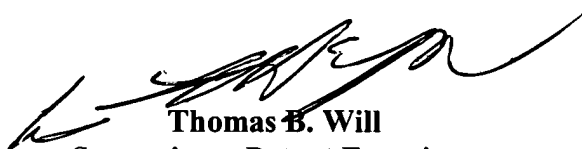
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Mammen whose telephone number is (571) 272-6991.

The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached at (571) 272-6998. The fax number for this Group is (703) 872-9306.

A handwritten signature in black ink, appearing to read 'Thomas B. Will', is written over the printed name.

Thomas B. Will
Supervisory Patent Examiner
Group 3600

NSM
4/12/05

Nathan S. Mammen